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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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COUDERT BROTHERS LLP 333 SOUTH HOPE STREET 23RD FLOOR LOS ANGELES, CA 90071			LEE, CHEUKFAN	
			ART UNIT	PAPER NUMBER
			2627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,315

Applicant(s)

HAN ET AL.

Examiner

Cheukfan Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 2,10,12,and 15-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

1. Claims 1-20 are pending. Claims 1, 6 and 13 are independent.
2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibe et al. (U.S. Patent No. 5,838,364) in view of McConica et al. (U.S. Patent No. 5,710,425).

Regarding claim 1, Ishibe et al. discloses a scanner (film player 1) comprises a housing (Figs. 1-3, 4A-4C), a digital camera (a combination of a light source (5) for illuminating an original, a line sensor (CCD 17) for converting light from the original to an electrical signal, an A/D converter (52) positioned within the housing, and a control system (CPU 40) for controlling scanning of objects (including piece film 13) (Fig. 6, Fig. 16(A)). The control system (40) has software to convert the digital image data stored in a main memory (54) according to a predetermined scale of the display memory (56) of the display (television monitor). The main memory (54) is formed by $2n$ by $2m$ pixels (each having 6-bit gradation), and the display memory (56), which is in one-to-one

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correspondence to the screen of display monitor (TV monitor), is formed by n by m pixels (each having 6-bit gradation). The data are transferred from the main memory (54) to the display memory (56) by skipping every other data of the main memory (54). The data in the display memory (56) are displayed on the display monitor (col. 9, line 12 – col. 10, line 20 and lines 41-49).

Although Ishibe et al. shows in Fig. 4B something that seems to be a supporting surface for the piece film (13) during scanning, Ishibe et al. does not show a “scanning surface” on the housing for housing the digital camera.

McConica et al. discloses a scanner for scanning a transparent document including a film strip (col. 2, line 61 – col. 3 line 17, col. 2, lines 18-31) placed on a **scanning surface** of a housing (base housing 105).

The scanner of McConica et al. is a dual resolution scanner for scanning a transparent original and an opaque original. Since the scanners of both McConica et al. and Ishibe et al. are for scanning a film strip (or piece film), it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the scanner housing and structure of Ishibe et al. to provide a housing having a scanning surface thereon on which the film strip is placed during scanning, in order to provide a scanner having a structure which allows generation of image data not only from a film but also from an opaque original, increasing the flexibility in the kinds of originals.

Regarding claim 3, the display of Ishibe et al. is a television monitor.

Regarding claim 5, the software of the CPU allows changing the scale of the displayed image (Ishibe et al., col. 9, lines 41-49), col. 10, lines 10-25).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibe et al. (U.S. Patent No. 5,838,364) in view of McConica et al. (U.S. Patent No. 5,710,425) as applied to claim 1 above, and further in view of Deguchi et al. (U.S. Patent No. 5,754,713).

Claim 4 recites "The scanner of claim 1 further including a removable data storage medium".

Ishibe et al. in view of McConica et al. does not comprise a removable data storage medium. However, an image reading device having a removable data storage medium is taught by Deguchi et al. (col. 5, lines 33-39 and col. 8, lines 38-53). The removable data storage medium is inserted into slot (9 in Fig. 1).

Please note that it is the removable data storage medium in Deguchi et al. that is relied on in this Office action, not the structure of the image scanner.

Since storing scanned in data in the removable data storage medium within the scanner of Deguchi et al. provides portability of the data, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ishibe et al. in view of McConica et al. with a features of having the scanned in data stored in a removable data storage medium, as taught by Deguchi et al., for the portability of the data.

It is understood that storing the scanned in data in the removable data storage medium does not stop the data being sent to the display monitor (in Ishibe et al.).

6. Claims 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConica et al. (U.S. Patent No. 5,710,425) in view of Applicant's admitted prior art.

Regarding claim 6, McConica discloses a system comprising a scanner, a computer and other devices. The scanner converts a scanned object image to digital data in the controller (160 in Fig. 1A) having microcontroller (302 in Fig. 3) and transmits the digital data to central processing unit (computer in Fig. 1A) via link (161) including an RS-232, which is a digital data link (col. 2, lines 46-60).

The central processing unit (CPU) (computer in Fig. 1A) is a stand alone CPU for receiving digital data from the scanner, and inherently contains software to process the digital data for storage or display at a predetermined scale. Though McConica does not explicitly disclose that the computer transmits the digital data to a storage medium, such function of transmitting digital data to a storage medium for the purpose of storing the data for future use, which storage medium is in the computer itself, is inherent in the computer of McConica.

McConica does not specifically disclose a stand alone display device to receive digital data representative of the object image from the CPU (computer in Fig. 1A) and to convert the digital data to a displayed image of a predetermined scale. However, prior art stand alone display devices including LCD projectors are conventional or prior

art as discussed by Applicant on page 27, line 22 to page 30, line 37. The prior art projector 510 has a main connection panel located on the rear of the projector, which is where a variety of computer(s) are connected. Also, the same prior art or conventional LCD projector (510) is discussed on page 36, line 11 of Applicant specification.

One of ordinary skill in the art would have realized the benefit of connecting the computer of McConica to the connection panel of the projector, which is to display data transmitted from the computer on the projector screen for easy viewing during a conference. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the computer of McConica to the connection panel of the projector of Applicant's prior art such that the projector receives digital data representing the object image (the document image of McConica) and converts the digital data to a displayed image of a predetermined scale, in order present the object image in a conference. Please note that the scale of the displayed image on the screen (512) of the LCD projector (510) is inherently a predetermined scale.

Regarding claim 7, the scanner of McConica is for creating an object image from a reflective (or opaque) document or an object image from a transparent document, both types of documents share the same scanning platform (where object 115 is placed in Fig. 1A). This platform meets the claimed limitation when taking the "or" from "and/or" as the claim limitation for the purpose of this rejection.

Regarding claims 8 and 9, claim 8 recites "The scanner projection system of claim 6 further including a digital data storage medium", and claim 9 recites "The

scanner projection system of claim 6 further including removable digital data storage medium". Since the system of McConica in view of Applicant's prior art discussed above includes the computer (in Fig. 1A of McConica), the computer inherently comprises a removable digital data storage medium.

Regarding claim 11, Applicant's prior art display device is an LCD projector (510) having a screen (512) as discussed for claim 6 above.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by McConica (U.S. Patent No. 5,710,425).

Regarding claim 6, McConica discloses a system and a method comprising a scanner, a computer and other devices. The scanner, which is a stand alone scanner, converts a scanned object image to digital data in the controller (160 in Fig. 1A) having microcontroller (302 in Fig. 3) and transmits the digital data to central processing unit (computer in Fig. 1A) via link (161) including an RS-232, which is a digital data link (col. 2, lines 46-60). The computer inherently displays the received image on its inherent display monitor. Further, the controller (microcontroller 302 in Fig. 3) has an inherent

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digital data storage medium for storing the converted digital data (col. 3, line 3, line 58 – col. 4, line 7).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over McConica (U.S. Patent No. 5,710,425) in view of Deguchi et al. (U.S. Patent No. 5,754,713).

Regarding claim 14, McConica discussed for claim 13 above does not disclose that the storage medium is moveable. However, employ a removable storage medium for storing image data in a scanner is taught by Deguchi et al. (col. 5, lines 25 and 33-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a removable storage medium as the digital storage medium of McConica as taught by Deguchi et al. to provide the user the convenience of transporting or handling the data.

10. Claims 2, 10, 12, 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is an examiner's statement of reasons for allowance:

Claim 2 would be allowable because the image display device, to which the digital data is transmitted from the obvious scanner of Ishibe et al. in view of McConica discussed for claim 1, is not an LCD projector. The examiner found no motivation to modify the system of Ishibe et al. having a TV monitor for displaying the received data to include an LCD projector.

Claim 10 requires a television monitor as the display device. The display device of the obvious scanner projection system of McConica in view of Applicant's prior art discussed for claim 6 is an LCD projector, not a TV monitor. Claim 10 would be allowable over the prior art of record.

Claim 12 requires that the CPU is further adapted to receive signals from an infrared (IR) remote control device, to convert the IR signals to digital data representative of the IR signals, containing software to process the digital data to change the digital data representative of the object image transmitted to the display device to alter the scale and or/portion of the portion of the object image displayed. McConica does disclose that the computer (Fig. 1A) is adapted to receive and process IR signals as claimed and contains software to alter the scale and/or position of the portion of the object image displayed as claimed. The system of McConica in view of Applicant's prior art discussed for claim 6 does not have the CPU as claimed.

Claims 15-18 would be allowable because McConica does not disclose that the installed software is adapted to allow changing the displayed image scale, or is adapted to allow the portion of the image displayed to be shifted vertically and horizontally as claimed.

Claims 19 and 20 would be allowable because the image display device of McConica is a computer display monitor, not a television monitor or an LCD projector as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee

A handwritten signature in black ink, appearing to read "Cheukfan Lee". The signature is stylized with a large, looped initial "C" and "L".